

REMARKS

The Final Office Action mailed January 18, 2008 has been received and carefully noted. Claims 1-22 are currently pending in the subject application and are presently under consideration.

Claims 1, 7, 18, and 22 have been amended herein. A listing of claims can be found on pages 2-6 of this Reply.

Favorable reconsideration of the pending claims is respectfully requested in view of the amendments and the following comments.

I. Rejection of Claims 1, 7, 18, and 22 Under 35 U.S.C. § 112

Claims 1, 7, 18, and 22 stand rejected under 35 U.S.C. § 112, first paragraph. The Applicants have amended these claims to overcome this issue. Reconsideration and withdrawal of these rejections are respectfully requested.

II. Rejection of Claims 1-9, 11-12, 14-16, 18-20, and 22 Under 35 U.S.C. § 102(e)

Claims 1-9, 11-12, 14-16, 18-20, and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burroughs *et al.* (U.S. 7,111,158). It is requested that this rejection be withdrawn for at least the following reason. Burroughs *et al.* does not describe each and every element of the claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegall Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Amended independent claims 7, 18, and 22 recite: "the second device being a fail over switch that provides *two paths between the host and the*

first device” (emphasis added) or analogous aspects. Burroughs *et al.* does not disclose this aspect.

The Examiner contends that Burroughs *et al.* discloses “a fail over switch that provides for *two paths between the host controller and the serial ATA device*” by the communications medium of Figs. 1-4 (See Final Office Action mailed January 18, 2008, pg. 7). The Applicants respectfully disagree.

The communications medium of Burroughs *et al.* does not provide two paths between a host controller and a serial ATA device. Rather, the communications medium provides one path between a host controller and the serial ATA device and another path between a different host controller and the serial ATA device. Accordingly, each host controller disclosed in the cited reference is configured to have just a single path to the serial ATA device. Since Burroughs *et al.* does not disclose two paths between a host and a serial ATA device, Burroughs *et al.* cannot also disclose an out of band signal that “notifies the host controller that *a switch between the first path and the second path of the fail over switch has occurred*” (emphasis added), as recited in independent claim 22 because the two paths recited in the claims do not exist in the cited reference.

Amended independent claim 22 recites the further limitation: “a fail over switch that provides for a first path and a second path between the host controller and the serial ATA device, *the second path to be utilized when the first path fails*” (emphasis added). As explained above, Burroughs *et al.* does not disclose two paths between a host and a serial ATA device, much less where one path is utilized when the other path fails.

In addition, amended independent claim 1 recites:

the host detecting a presence of the second device, in response to receipt of the second signal if the host is of a *first set of hosts*; and
the host ignoring the second signal if the host is of a *second set of hosts*.

(emphasis added). Burroughs *et al.* does not describe these aspects.

The Examiner cites Burroughs *et al.* at Figs. 1, 3, and 4, col. 7, ll. 13-21, col. 8, ll. 27-32, col. 4, line 64 – col. 5, line 4, and col. 8, ll. 27-32 as teaching “the host detecting a presence of the second device, in response to receipt of the second signal if the host is of a *first set of hosts*” (See Final Office Action mailed January 18, 2008, pg. 4). The Examiner adds that “since the host receives a signal from the communication [sic] medium 28 in response to its initial message, understandably, the host knows the presence of the medium or switch 28” (See *Id.*).

Burroughs *et al.* involves a system of multiple hosts that share control of a single serial ATA device through use of a communications medium (See Burroughs *et al.*, Figs. 1-4, col., 3, ll. 34-37). The hosts transmit commands to the serial ATA device to transition between sleep mode and normal mode in order for the serial ATA device to switch between hosts (See Burroughs *et al.*, col., 3, ll. 63-66, col. 8, ll. 27-32). When the serial ATA device is in sleep mode, control of the device can switch from one host to another (See Burroughs *et al.*, col., 3, line 66 – col., 4, line 2). When the serial ATA device is in normal mode, the device can exchange data with the connected host (See Burroughs *et al.*, col. 4, ll. 2-6). The communications medium provides a way for message exchange between a serial ATA device and multiple hosts.

Signals 36(1) and 36(2) of Burroughs *et al.*'s Figure 1 denote the path for signals based on which host has control over the serial ATA device (See Burroughs *et al.*, col. 4, line 64 – col. 5, line 4). In Figure 1, if host 26(1) has control of the serial ATA device, then signals would proceed through 36(1) to the host 26(1). If host 26(2) has control of the serial ATA device, then signals would proceed through 36(2) to the host 26(2). However, there is no indication that the host receiving the signal would react differently if the host is a “first set of hosts” or a “second set of hosts.” Further, there is no indication that the signals 36(1) and 36(2) sent to their respective hosts would be ignored by the hosts.

Signals 84 (Figure 3) and 104 (Figure 4) of Burroughs *et al.* represent the confirmation messages provided to the host with control of the serial ATA device to confirm that switching of control to that host has occurred (See Burroughs *et al.*, col. 7, ll.

13-21). The Examiner states that since a confirmation message “is optional, it is obvious that the host ignores the signal” (See Final Office Action mailed January 18, 2008, pg. 5). The Applicants respectfully disagree with the Examiner’s characterization of “optional.”

Burroughs *et al.* indicates that “[o]ptionally, the control circuit 52 may be equipped to provide confirmation messages 84 back to the hosts 26 to confirm proper switching of the multiplexer circuit 48” (See Burroughs *et al.*, col. 7, ll. 13-16). This means that the confirmation messages would be an optional feature of Burroughs *et al.*’s communications medium. This does not mean that a host would “ignore” such message; rather, the confirmation message is not required to be sent to the host in the first place. If the Examiner maintains this rejection, the Applicants respectfully request that the Examiner clarify when the host would be a “first set of hosts” and when the host would be a “second set of hosts.”

Independent claims 11 and 14 recite: “a host transmitting a COMRESET to a device coupled with a switch; *the host receiving a COMWAKE originating from the switch*; the host identifying a presence of the switch, in response to receipt of the COMWAKE” (emphasis added) or analogous aspects. Burroughs *et al.* does not disclose these aspects.

The Examiner cites the same sections of Burroughs *et al.* above (*i.e.*, Figs. 1-4, col., 4, line 66 – col. 5, line 4, col., 7, ll. 13-16). The Examiner appears to equate the switch of the subject claims with the communications medium of Burroughs *et al.* (See Final Office Action mailed January 18, 2008, pg. 6).

Burroughs *et al.* discloses a host sending a wake command, such as the COMWAKE command, to the serial ATA device to transition the serial ATA device from sleep mode back to normal operating mode (See Burroughs *et al.*, col., 7, 17-21). While the host communicates with the serial ATA device through the communications medium, the COMWAKE command originates from the **host**, and not the communications medium.

Each of the dependent claims depend from one of the independent claims, incorporating the respective limitations thereof. For at least the aforementioned reasons

regarding the independent claims, Burroughs *et al.* does not describe each and every element of the dependent claims. Accordingly, it is respectfully requested that these rejections be withdrawn.

III. Rejection of Claims 10, 13, 17 and 21 Under 35 U.S.C. § 103(a)

Claims 10, 13, 17, and 21 stand rejected under 35 U.S.C. § 103(a) as obvious over Burroughs *et al.*, in view of Grieff *et al.* (U.S. 6,948,036). It is requested that this rejection be withdrawn for at least the following reason. To establish a *prima facie* case of obviousness, the Examiner must show that the cited references, combined, teach or suggest each of the elements of the claims. In particular, claims 10, 13, 17, and 21 depend from independent claims 7, 11, 14, and 18, respectively, and thus incorporate the respective limitations thereof. The Examiner has not relied upon and the Applicants do not discern any part of Grieff *et al.* that cures the aforementioned deficiencies of Burroughs *et al.* regarding independent claims 7, 11, 14, and 18. For at least the above reasons regarding independent claims 7, 11, 14, and 18, Burroughs *et al.* and Grieff *et al.*, alone or in combination, fail to teach or suggest each element of claims 10, 13, 17, and 21. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

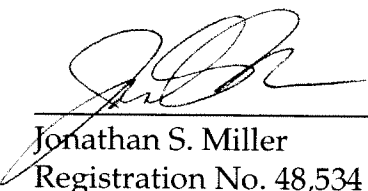
In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted to the United States Patent and Trademark Office electronically via EFS Web on the date shown below.


Melissa Stead

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Date